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EXAMINER

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ART UNIT

PAPER NUMBER

2731

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
08/479,215

Applicant(s)  
HARVEY et al

Examiner  
William Luther

Group Art Unit  
2731



☒ Responsive to communication(s) filed on Jul 3, 1997

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 10-12 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 10-12 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### DETAILED ACTION

1. This action is in response to Amendment D received on July 3, 1997.

#### *Response to Arguments*

2. Applicant's arguments with respect to claims 10-12 have been considered but are moot in view of the new ground(s) of rejection. The amendments to the claims, having altered the claim scope by adding limitations, have caused new interpretation of the claim scope. Additionally, it is noted that the priority date of the instant disclosure is claimed by applicant to the '87 document (U.S. patent no. 4,965,825 filed Sep 11, 1987- reference Amendment D pg 8 section C).

Next, while the former rejection was tailored to help any reader understand how easily the art of rejection read on the claims (before amendment) in an effort to be helpful, the interpretations provided by the first action on the merits (former rejection) should not be wrongly construed as being comprehensive, but should be considered as being merely exemplary.

It is noted that applicant has argued continuously throughout the remarks of Amendment D that the rejecting reference(s) do not read on the claim language. There is disagreement. The reference(s) of rejection did in deed read on the claim language and this is clearly evidenced by the amendments to the claims.

Further, applicant sets forth continuous arguments for distinguishing: 1) the claims as now amendment from the rejection that corresponded to the claims before they were amended; 2) the reference used in rejection and the claims as now amended. Regarding 1), any exercise of

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showing how a former rejection reads on a current claim is not necessary and is found to be inappropriate, therefore such an exercise will not be performed. Regarding 2), this action will provide examples in parenthesis, throughout art rejections given, of how art of rejection reads on the newly modified claim scope.

Further, the remarks of Amendment D have been found to be riddled with mis-characterizations as well as completely inaccurate statements corresponding to Saeki et al (the art used in rejection in the former office action prior to the newly modified claim scope). The mis-characterizations and the inaccurate statements which correspond to current claim language are addressed below with the use of the parenthesis.

### ***DOUBLE PATENTING***

3. In view of further analysis and applicant's arguments, the rejection of the claims in the instant application under double patenting based on the broad analysis of *In re Schneller* as set forth in the previous Office Action has been withdrawn.

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***DOUBLE PATENTING BETWEEN APPLICATIONS***

4. Conflicts exist between claims of the following related co-pending applications which includes the present application:

#	Ser. No.	#	Ser. No.	#	Ser. No.
1	397371	2	397582	3	397636
4	435757	5	435758	6	437044
7	437045	8	437629	9	437635
10	437791	11	437819	12	437864
13	437887	14	437937	15	438011
16	438206	17	438216	18	438659
19	439668	20	439670	21	440657
22	440837	23	441027	24	441033
25	441575	26	441577	27	441701
28	441749	29	441821	30	441880
31	441942	32	441996	33	442165
34	442327	35	442335	36	442369
37	442383	38	442505	39	442507

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40	444643	41	444756	42	444757
43	444758	44	444781	45	444786
46	444787	47	444788	48	444887
49	445045	50	445054	51	445290
52	445294	53	445296	54	445328
55	446123	56	446124	57	446429
58	446430	59	446431	60	446432
61	446494	62	446553	63	446579
64	447380	65	447414	66	447415
67	447416	68	447446	69	447447
70	447448	71	447449	72	447496
73	447502	74	447529	75	447611
76	447621	77	447679	78	447711
79	447712	80	447724	81	447726
82	447826	83	447908	84	447938
85	447974	86	447977	87	448099
88	448116	89	448141	90	448143
91	448175	92	448251	93	448309
94	448326	95	448643	96	448644
97	448662	98	448667	99	448794

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100	448810	101	448833	102	448915
103	448916	104	448917	105	448976
106	448977	107	448978	108	448979
109	449097	110	449110	111	449248
112	449263	113	449281	114	449291
115	449302	116	449351	117	449369
118	449411	119	449413	120	449523
121	449530	122	449531	123	449532
124	449652	125	449697	126	449702
127	449717	128	449718	129	449798
130	449800	131	449829	132	449867
133	449901	134	450680	135	451203
136	451377	137	451496	138	451746
139	452395	140	458566	141	458699
142	458760	143	459216	144	459217
145	459218	146	459506	147	459507
148	459521	149	459522	150	459788
151	460043	152	460081	153	460085
154	460120	155	460187	156	460240
157	460256	158	460274	159	460387

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160	460394	161	460401	162	460556
163	460557	164	460591	165	460592
166	460634	167	460642	168	460668
169	460677	170	460711	171	460713
172	460743	173	460765	174	460766
175	460770	176	460793	177	460817
178	466887	179	466888	180	466890
181	466894	182	467045	183	467904
184	468044	185	468323	186	468324
187	468641	188	468736	189	468994
190	469056	191	469059	192	469078
193	469103	194	469106	195	469107
196	469108	197	469109	198	469355
199	469496	200	469517	201	469612
202	469623	203	469624	204	469626
205	470051	206	470052	207	470053
208	470054	209	470236	210	470447
211	470448	212	470476	213	470570
214	470571	215	471024	216	471191
217	471238	218	471239	219	471240



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220	472066	221	472399	222	472462
223	472980	224	473213	225	473224
226	473484	227	473927	228	473996
229	473997	230	473998	231	473999
232	474119	233	474139	234	474145
235	474146	236	474147	237	474496
238	474674	239	474963	240	474964
241	475341	242	475342	243	477547
244	477564	245	477570	246	477660
247	477711	248	477712	249	477805
250	477955	251	478044	252	478107
253	478544	254	478633	255	478767
256	478794	257	478858	258	478864
259	478908	260	479042	261	479215
262	479216	263	479217	264	479374
265	479375	266	479414	267	479523
268	479524	269	479667	270	480059
271	480060	272	480383	273	480392
274	480740	275	481074	276	482573
277	482574	278	482857	279	483054

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280	483169	281	483174	282	483269
283	483980	284	484275	285	484276
286	484858	287	484865	288	485282
289	485283	290	485507	291	485775
292	486258	293	486259	294	486265
295	486266	296	486297	297	487155
298	487397	299	487408	300	487410
301	487411	302	487428	303	487506
304	487516	305	487526	306	487536
307	487546	308	487556	309	487565
310	487649	311	487851	312	487895
313	487980	314	487981	315	487982
316	487984	317	488032	318	488058
319	488378	320	488383	321	488436
322	488438	323	488439	324	488619
325	488620	326	498002	327	511491
328	485773	329	113329		

5. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required

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in the absence of good and sufficient reason for their retention during pendency in more than one application. The attached Appendix provides clear evidence that such conflicting claims exist between the 329 related co-pending applications identified above. However, an analysis of all claims in the 329 related co-pending applications would be an extreme burden on the Office requiring millions of claim comparisons.

In order to resolve the conflict between applications, applicant is required to either:

- (1) file terminal disclaimers in each of the related 329 applications terminally disclaiming each of the other 329 applications, or;
- (2) provide an affidavit attesting to the fact that all claims in the 329 applications have been reviewed by applicant and that no conflicting claims exists between the applications. Applicant should provide all relevant factual information including the specific steps taken to insure that no conflicting claims exist between the applications, or;
- (3) resolve all conflicts between claims in the above identified 329 applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 329 applications (note: the five examples in the attached Appendix are merely illustrative of the overall problem. Only correcting the five identified conflicts would not satisfy the requirement).

Failure to comply with the above requirement will result in abandonment of the application.

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***INFORMATION DISCLOSURE STATEMENTS***

6. Receipt is acknowledged of applicant's Information Disclosure Statements filed December 11, 1995, December 22, 1995, February 6, 1996, April 17, 1996, April 7, 1997. In view of the unusually large number of references cited in the instant application (approximately 2,200 originally and 645 in the subsequent IDS) and the failure of applicant to point out why such a large number of references is warranted, these references have been considered in accordance with 37 C.F.R. 1.97 and 1.98 to the best ability by the examiner with the time and resources available.

The foreign language references cited therein where there is no statement of relevance or no translation are not in compliance with 37 C.F.R. 1.98 and have not been considered. Numerous references listed in the IDS are subsequent to applicant's latest effective filing date of 9/11/87, therefore, the relevancy of these references is unclear. Also cited are numerous references that are apparently unrelated to the subject matter of the instant invention such as: US Patent # 33,189 directed toward a beehive, GB 1565319 directed toward a chemical compound, a cover sheet with only the word "ZING", a computer printout from a library search with the words "LST" on it and a page of business cards including that of co-inventor James Cuddihy, among others. The relevancy of these references cannot be ascertained. Furthermore, there are several database search results listed in foreign languages (such as German) which list only the title and document information; no copy has been provided, therefore, these references have not been considered.

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***Claim Objections***

7. Claim 10 is objected to because of the following informalities: a semicolon is suggested to be inserted following “programming” (line 6). Appropriate correction is required.

***Specification***

8. The amendment filed July 3, 1997 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure.

Considering claim 10, no support is found within the disclosure for how it is possible that “at least one message” (line 20) can be assembled in the receiver (per claim breadth; noting that the assembling can occur anywhere in the network -wherein the receiver is part of the network) and still subsequently be received by the receiver ie “receiving a signal containing at least a portion of said at least one message” (lines 23-24). In other words how can the “at least one message” be both assembled and received by the same receiver --an interpretation conveyed by the instant claim breadth. Thus, the claim scope extends to encompass a seemingly impossible situation.

Applicant is required to cancel the new matter in the response to this Office action.

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***CLAIM REJECTIONS - 35 U.S.C. § 112***

9. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

**37 C.F.R. 1.75(d)(1) requires that:**

**“the terms and the phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description”.**

Considering claim 10, no support is found for the following 6th permutations positively recited (see lines 9, 13-14, and 17): 1) datum stored followed by code selected and code communicated; 2) datum stored followed by code selected and datum communicated; 3) datum stored followed by datum selected and code communicated; 4) code stored followed by datum selected and datum communicated; 5) code stored followed by datum selected and code communicated; 6) code stored followed by code selected and datum communicated. This rejection is necessitated by both: 1) amendment; and 2) inadequate response to section 14 beginning on page 18 of the prior office action. Regarding 2) the response to this paragraph seems to be found with remarking toward examples #1-#9 (see Amend D pg 5 thru top of pg 8). However, the claim (per amendment and after remark) can still: a) not properly be diagramed; b) not be supported by the disclosure; and is still vague and indefinite (see 112 second below).

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Although, it seems applicant has attempted to clear up confusion by discussing examples #1-#9 in combination with amendments (so as to delete 'or' type permutations --see corresponding deletions and additions to claim 10 on lines 9, 13-14, and 17), the confusion still exists. For these reasons, the claim limitations have not been found to be enabled by the disclosure.

This rejection is made in response to both amendment and inadequate redress of section 14 of the prior office action.

10. Claims 10-12 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Considering claim 10, the claim is vague and indefinite for not providing sufficient antecedent reference for: "combined medium programming" (lines 4 and 6: does this refer to the 'specific combined medium programming' recited in lines 1-2, or different?); "said specific combined medium programming" (lines 7-8 and 25-26; does this refer to 'combined medium programming' -lines 4 and 6, or only to lines 1-2 'specific..programming' or all three 'combined' recitations ?). Claim 10 is further vague and indefinite for the following: if it is the "datum" (line 9) that is stored in the memory then how would it be possible to select "said code" (line 14)? Vice versa--if it is the code stored in memory then how would it be possible to select "said datum" (line 14)? Further, if it is the datum that is 'stored' and 'selected', then how is it possible for "communicating one of said selected code" (line 17). Vice versa, the claim is not clear how if

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it is the code that is 'stored' then how could the 'datum' be 'selected' and 'communicated'. In summary to this issue, the claim language is unclear as to what permutations are meant to be conveyed via claim breadth regarding the various combinations of 'storing', 'selecting' and 'communicating' (see permutations listed in rejection under 112 first paragraph above).

This rejection is made in response to both amendment and inadequate redress of section 14 of the prior office action.

Further considering claim 10, because the "assembling" of the message (line 20) can occur anywhere in the network (per claim breadth), it is not clear then how in the case where the 'assembling' occurs in the receiver, how the 'receiver' can receive a portion of the at least one message (lines 23-24)? This rejection is specifically necessitated by amendment.

Further considering claim 10, the claim does not provide sufficient antecedent recitation for: "remote station" (line 24; does this refer to the 'remote site' recited in line 16 or other?).

Considering claim 11, the claim does not provide sufficient antecedent recitation for: "combined medium programming" (line 4; does this refer to the 'specific' in line 1); "said specific combined medium program" (lines 6 and 7 respectively; does the refer both to the 'specific recitation' on line 1 and the 'combined medium programming' -line 4 or just the first and not the second?); "combined medium programming" (lines 7-8; which recitation does this refer to?); "combined medium programming" (lines 9-10; does this refer only to line 4 or to all of lines 4, 1, 6, and 7 or a sub-combination?); "said specific combined medium programming" (lines 11-12).

Considering claim 12, the claim does not provide sufficient antecedent recitation for:



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“combined medium programming” (line 4; does this refer to the ‘specific’ recitation on line 1?); “specific combined medium program” (lines 7-8 and 8 respectively; does this refer to line 1 only or does it relate to line 4 or both?); “said combined medium programming” (line 10; 18); “said specific combined medium programming” (line 12). Further the claim is vague and indefinite in whether the last four lines (lines 23-26) are limited to sub-step a or to sub-step b or apply to the claim irrespective of which alternate (a or b) is performed.

Further considering claim 12, the claim does not provide sufficient antecedent recitation for: “said specific combined medium programming” (interpretation is given that this recitation must not refer to any of sub-step a because if sub-step b was selected then sub-step a would have been skipped and would thus be considered irrelevant to considering antecedence; does this refer to line 1 or line 4 or both?). Further, the claim language is found to lack sufficient antecedent reference for: “said transmitter station” (lines 23-24; if it was sub-sub-step b that was performed then there is no antecedent basis for ‘said transmitter station’ therefore the claim scope is vague and indefinite); “a transmitter” (line 24; does this refer to the transmitter station -lines 23 thru 24- or different).

### ***CLAIM REJECTIONS - 35 U.S.C. § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Rejections are made with Examiner's best understanding of scope of claims. Any amendment to overcome rejection under 35 U.S.C. 112 that changes Examiner's understanding of claim scope may necessitate citation of new art.

12. Claims 10-12 are rejected under 35 U.S.C. 102(a, b and e) as being anticipated by Saeki et al (U.S. patent no. 4,455,570).

Considering claims 10-11, Saeki et al suggest: a method for specific (broad but reasonable claim interpretation: restricted to a particular situation; Saeki et al suggest ordering specific data upon subscriber input to keyboard 44 information for requesting programming from a data list - col 6 lines 7-39) combined (together; Saeki et al suggest a network having subscriber sites -see F1 #'s2- and having a center site -F1 #1- and other network communication path elements -F1 #'s 3, 4, 5, 6, 9, etc.... wherein the multiple elements of the network which include the combination and sub-combination and parts to each of subscriber sites, center, and other communication path elements) all work together -combined- and -in combination- to provide subscribers at #2 type sites programming on demand ---"requested data is reproduced on individual receivers of subscribers through a particular channel in the same system" col 3 lines 9-11---; note that the

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requested data suggested by Saeki et al includes signaling of both text, audio, and video information) medium (noun: something in a middle position that is effective to convey; Saeki et al suggest a path to convey which consists of a combination of elements F1 #'s 1, 2, 3, 4, 5, 6, ...etc whose whole and parts function in a combined manner to convey the requested data to the subscriber) programming (plan under which action may be taken toward a goal; Saeki et al suggest an action of F1 #1 answering request for data -col 3 line 9- for achieving the goal of the subscriber actually receiving and utilizing the requested data at #2 sites) delivery (conveying; Saeki et al suggest the delivery of the requested data -col 3 line 9) for use with an interactive (reciprocating; Saeki et al suggest that the subscribers would request data via keyboard 44 -col 6 line 8- and in reciprocation to the request the subscriber is able to view the requested data -col 3 line 9) mass (of or relating to a mass of people; Saeki et al suggest a cable television system wherein the subscribers located at F1 #2's are the mass in combination with other subscribers implied and inherent to the cable system environment) medium (noun: something in a middle position; Saeki et al suggest the combined operation of communication channel comprising F1 #'s 1, 2, 3, ...etc to be located and to operate in the middle ...ie between the subscriber or person intended to sit at F1 #11 site and the data sources located at F1 group #14) program (see definition above; see interpretation above) output apparatus (structure which produces; Saeki et al suggest producing the requested data at F1 #2's) having an input device (structure that receives information; Saeki et al col 6 line 9 teach a keyboard 44 which meets this limitation) to receive input from a subscriber (the person intended by Saeki et al suggestion to depress the buttons 50 -

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col 6 line 7); prompting the subscriber (move to action; Saeki et al suggest menus which are intended to move the subscriber into the action of pressing various #50 buttons for viewing various data corresponding to F4-F7) during the combined medium programming (defined above); the interactive mass medium program output apparatus (defined above) having a memory (structure which has the power to reproduce or recall what has been learned and retained especially through associative mechanisms; Saeki et al suggest a structure which both a) meets broad but reasonable definition of what is a 'memory' b) performs the functions positively recited by the claim corresponding to the memory ie 'for storing a code'

--- particularly, Saeki et al F2c suggest that "command signal generator 41-3 produces a coded command signal corresponding to the depression of the command buttons" at col 6 lines 15-17 wherein buttons 50 of keyboard 44 are what is depressed-- therefore, item 41-3 is a memory otherwise known as a structure which has the power to reproduce or recall the code(s) that correspond by association to the depressed buttons) for storing (placing in a location for preservation or later use; Saeki et al suggest placing and thus preserving codes into the command signal generator for use such that at any later time at which the subscriber depresses the button a corresponding code is produced) a code (system used to represent the letters of the alphabet, numerals, punctuation, and symbols; Saeki et al suggest the code be stored for association to depressed buttons at the command signal generator- see F2c item 41-3); receiving a reply from the subscriber at the input device in response to prompting the subscriber (Saeki et al suggest a reply in the form of a button depression of buttons #50 which are to be depressed in response to

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menus of F4-F7 prompting; see col 6 line 8) wherein the interactive mass medium program output apparatus (defined above) having processor (structure which performs a series of actions or operations toward a particular result; Saeki et al suggest the circuitry structure of items 44 and 41 be used to perform actions toward the result of the subscriber getting the data requested -col 3 line 9-) for processing the subscriber reply (defined above); processing the reply (defined above) and selecting one of the code (that code which corresponds to the button depression) designating the specific combined medium programming (defined above) the interactive mass medium program output apparatus (defined above) having a transmitter (that which sends or conveys; Saeki et al suggest that the code be sent or conveyed to the center #1-see col 6 line 24) for communicating with a remote site (separated by space; Saeki et al suggest various circuitry and sub-combinations of circuitry housed at #1 which meet the broad but reasonable definition given above for what is a remote site); communicating the code (explained above) to the remote site (explained above), said interactive mass medium output apparatus (defined above) forming part of a network (system of channels; Saeki et al suggest F's 1-3 of which the combination or various sub-combinations are considered a 'part of a system of channels') having a plurality (more than one) of transmitter (defined above; Saeki et al suggest that both #2's of F1 each have a transmitter as defined above) stations (position at which something stands; Saeki et al suggest that the transmitters each have a place to stand); assembling (bringing together; Saeki et al suggest an environment in which all requested data -col 3 line 9- asked for by both subscriber F1 #2's be brought together before transmission for the purpose of transmission away from F1 #1) in the

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network (defined above) at least one message (communication by signals; Saeki et al suggest that the requested programs of both F1 #2's -col 3 line 9- be communicated by signals from center F1 #1 to the respective F1 #2) which is effective at the interactive mass medium program output apparatus (defined above) to satisfy the reply (explained above) wherein the interactive mass medium program output apparatus (defined above) having a receiver (structure which receives; Saeki et al suggest that each F1 #2 be equipped with structure that receives the requested data - col 3 line 9) for receiving a signal (that which conveys information; Saeki et al suggest conveying the requested data information -col 3 line 9 to the subscriber sitting at location F1 #2) containing the message (defined above; Saeki et al suggest that the subscriber at F1 #2 actually receive the data that is requested) from the remote station (position at which something stands separated by space; Saeki et al suggest center F1 #1 which in combination or sub-combination is considered to meet the broad but reasonable definition of what is a remote location because it is separated by space from F1 #2's and it has a position to stand); delivering the designated specific combined medium programming (defined above) on the basis of the messages (defined above).

Considering claim 12, Saeki et al suggest: a method for specific combined medium programming delivery for use with an interactive mass medium program output apparatus (explained above) comprising steps of receiving a combined medium programming transmission to be transmitted (F1 #19 receives programming from group 14 to be transmitted to F1 #2 sites) receiving an instruct signal (communication which teaches; Saeki et al suggest a communication from the F1 #1 location to the F1 #2 location which teaches the #2 location what menu options to

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display to the subscriber -F4) which is effective at a receiver station (location which receives; Saeki et al suggest that #2 comprise equipment, that either in combination or sub-combination, that is considered receiver station) to perform recited sub-step b generation of specific combined programming (defined above; there is specification for specific menus which specify specific options from which the subscriber may choose -see F4-F7) wherein the combined programming enables the interactive mass medium program output apparatus to prompt (defined above; explained above) a subscriber for input (explained above) in respect of the combined medium programming (defined above; explained above) receive and process a reply (explained above) from the subscriber; communicate code (defined above; explained above) designating the specific combined medium programming (defined above; explained above); and receive at a message satisfying the reply from the subscriber (explained above); receiving a transmitter control signal (that which controls the transmitter; Saeki et al suggests that F1 #1 include an item 22 which inherently receives a frequency oscillation envelop necessary for the process of up-conversion for the subsequent transmission from #1 to #2); which operates at the transmitter station (location having a structure that sends; Saeki et al suggest that #1 in combination or it's various elements in sub-combination) to communicate the combined medium program (explained above) to a transmitter (structure that transmits; Saeki et al suggest that F1 #1 comprise item 24 which functions to send) and transmitting a) the specific combined medium programming (defined above), b) instruct signal (defined above as communication which teaches; Saeki et al suggest a communication from the F1 #1 location to the F1 #2 location which teaches the #2 location what

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menu options to display to the subscriber -F4) and c) transmitter control signal (defined above as the envelope carrier inherent and necessary for up-conversion). In other words, the up-converting envelop transmit control signal is the carrier that acts to convey all information away from the #1 site, therefore the transmitter control signal is transmitted. Further, the instruct signal, which coordinates the fixing of the F4 menu is conveyed away from the #1 site, is thus also transmitted. And finally, the specific (defined above as restricted to a particular situation) combined (together) medium (something in a middle position that is effective to convey) programming (plan under which action may be taken toward a goal) or the specific programming (that which outputs from F1 #1's #14), meant for a transmission over a combined medium (the channel which puts together all user requested data -col 3 line 9 including the changing data associated with the fixed menu), is also conveyed or transmitted away from site #1.

### *Conclusion*

13. In order to avoid any confusion during the prosecution of this application, the following request is made. Applicant is requested to explicitly distinguish between categories of 'claim(s) as now amended' and 'claim(s) not amended' when making assertions that the claim(s) distinguish over the art of rejection.

14. Any After Final amendments that do not include clear limitations already addressed by a search of prior art would necessarily require further search and consideration.

15. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL



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AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

\*\*\*\*\*NOTICE\*\*\*\*\*

**Any response to this final action should be mailed to:**

**Box AF**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

(by addressing all After Final Office action responses to the above address, processing time of the responses is reduced. This will result in fewer requests for extension of time);

**or faxed to:**

(703) 308-9051, (for formal communications; please mark "EXPEDITED PROCEDURE")


**Or:**


(703) 305-9508 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Luther whose telephone number is (703) 308-6609. The examiner can normally be reached on Mon-Fri from 9:30am to 3pm.

17. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
William Luther  
January 30, 1998

  
CHI H. PHAM  
PRIMARY EXAMINER  
GROUP 2600 2700  
2/2/98